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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,977	06/28/2003	Kenneth Craig Barker		5763

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EXAMINER

SUHOL, DMITRY

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/608,977

Applicant(s)

BARKER, KENNETH CRAIG

Examiner

Dmitry Suhol

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 1, the applicants invoke 112, 6th paragraph by their use of means plus function language (e.g. other means for illustrating the structure of written words) however such means is not disclosed in the specification, therefore one skilled in the art would not be able to make and/or use the invention as claimed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly

and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

Examples of indefinite language are as follow:

Regarding claim 1, the structure encompassed by the phrase "...other means for illustrating the structure of written words" can't be determined, rendering the claim indefinite.

Regarding claim 3, the phrase "for instance" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Furthermore, there is no antecedent basis for "said backing board", "said bindings", "said sets of pages", "said pages" "said corresponding index tabs".

Regarding claim 4, there is no antecedent basis for "the set of pages", said binding", "said left edge of said backing board", "said pages", "said right edge of said backing board", "said final consonant blend pages", "the subsets of single vowels", "said vowel section", "said pages", "said three groups of pages". It should further be noted that terminology for claimed subject matter must be consistent and must not be changed (i.e. applicants must not change terminology by stating "hereafter referred to..." in the claims).

Regarding claim 5, there is no antecedent basis for terms such as "said attachment receptacles", "said attachment rods", "the set of pages", "the marvelous e page", "the not so marvelous e page", "the left attachment receptacle", "the attachment

rod", "said prefix pages", "said binding", "said pages", "the right attachment receptacle", "said female flange", "said rod", "the top of said page".

Regarding claim 6, there is no antecedent basis for "said vowel section".

Regarding claim 7, there is no antecedent basis for "said letters", "said letter clusters", "said not so marvelous e", "said schwa page".

Regarding claim 8, there is no antecedent basis for "said initial and final blend pages", "said letter clusters", "said letters", "said side mounted bindings", "the back of said backing board", "said single consonants", "said vowel teams", "said single vowels", "said consonant digraphs", "said initial and final consonant digraph pages", "said initial and final single consonant pages", "said vowel section", among others. Furthermore, the use of the term "and or" renders the claim indefinite as the metes and bounds of the claim can not be established.

Regarding claim 9, there is no antecedent basis for "said letters and letter clusters", "said consonants are colored blue", "said single consonants", "said consonant digraphs", "said silent letters", "said black outline form", "said single vowels", "said vowel teams", "the nearly silent letters", "said r-controlled vowel pages", "said prefixes", "said suffixes".

Regarding claim 10, the use of the term "and or" renders the claim indefinite as the metes and bounds of the claim can not be established.

Regarding claim 11, there is no antecedent basis for "said educational device", "said orthographic patterns", "said relationships of alphabetic letters".

Regarding claim 12, there is no antecedent basis for "said color coding", "said organization of sets of said letters and letter cluster", "said kinesthetic design elements".

Regarding claim 13, the features that are being claimed are not clear.

Regarding claim 14, the order claimed is not understood.

Regarding claims 11-14, it is not clear if applicants are attempting to claim structure or method step claims.

The reminder of the office action considers the claims as best understood.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Sprague '566. Sprague discloses a flip book type educational device which as best understood contains all of the claimed features including pages attached to a left and right side of a board having letters and letter clusters printed thereon (figures 1 and 3) and spiral binding (12).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sprague '566 in view of Deutch '340. Sprague further teaches a backing board (17), bindings (11), attachment receptacles (read onto the holes of the pages of decks 21, 31 and 41), attachment rods (rods 19), sets of pages (pages of decks 21, 31, 41), and single pages (pages in decks 21, 31 and 41).

Sprague lacks the teaching of a index tabs as required by claim 2, however Deutch teaches that it is known to provide a flip book which contains a plurality of pages with index tabs (44) for the purpose of identifying various information located on the pages easily and quickly. Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention to have included index tabs with the pages of Sprague for the purpose of identifying information on the pages easily and quickly.

Claims 3-5, 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sprague '566. As best understood Sprague discloses most of the claimed elements as stated above. With reference to specific indicia printed on the pages of the device and colors used, it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to incorporate the indicia as claimed since it would only depend

on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983) and *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of learning material does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. claimed indicia) and the substrate (e.g. pages of the flip book) which is required for patentability.

Regarding claim 10, the use of a computer would have been obvious since examiner takes official notice that educational language materials are notoriously known to be provided in a computer readable format.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sprague '566 in view of Collins '905 and Van Eycke '848. Sprague fails to teach a schwa indicia on one of his pages and a vertical handle as required by claim 6. However, Collins discloses an education device like that of Sprague which teaches that is know to provide schwa indicia with rotatable elements of the device (col. 2, lines 15-18) while Van Eycke also discloses an educational language device which teaches the cards utilized to form words having vertical handles (figure 9, handle 24). Therefore it would

have been obvious to include schwa indicia with the device of Sprague for the purpose of designating unaccented vowels as well as vertical handles with the cards of Sprague for the purpose of allowing a user to grasp and hold the card with ease.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dmitry Suhol
Examiner
Art Unit 3725